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PRE-APPEAL BRIEF REQUEST FOR REVIEWDocket Number(Optional)
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on March 5, 2007

Signature

Typed or printed

Name Mariah MoorheadApplication Number
10/699,399Filed
October 30, 2003First Named Inventor
Supratik GUHAArt Unit
2859Examiner
Mirellys Jagan

Application requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s)

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire Interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB.96)

attorney or agent record.

Registration number 37,333

Signature

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Registration number if acting under 47 CFR 1.34

Date

NOTE: Signatures of all the inventors or assignees of record of the entire Interest of their representatives(s) are required.
Submit multiple forms if more than one signature is required, see below*.



*Total of 1 forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.	:	10/699,399	Confirmation No. 3291
Applicant	:	Supratik Guha	
Filed	:	10/30/2003	
TC/A.U.	:	2859	
Examiner	:	Mirellys JAGAN	
Docket No.	:	YOR920030425US1	
Customer No.	:	23334	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following remarks are submitted with the Applicant's notice of appeal. The only issue on appeal is whether the combination of Davidson (U.S. Patent No. 6,140,141) and Paniccia (U.S. Patent No. 6,251,706), as set forth by Examiner Jagan in both the June 26, 2006 non-final Office Action and the December 4, 2007 Final Office Action, is proper.

In the non-final Office Action of June 26, 2006, independent claim 7 was rejected under 35 U.S.C. § 102(b) as being anticipated by Davidson and claims 3, 9, 10, 15-22, and 30 were rejected under 35 U.S.C. §103(a) as being unpatentable over Davidson in view of Paniccia.

In Applicant's reply to the June 26, 2006 non-final Office Action, Applicants pointed out that, as opposed to the present invention, which senses temperatures of an electronic device through detection of infrared (IR) radiation through an IR transparent window that serves as a wall to a cooling duct that passes fluid over the device, the Davidson reference discloses sensing voltages (not heat) through detection of polarization (not IR radiation) of light emitted from the device. Davidson, col. 1, lines 25-29. Applicants submitted an expert opinion, in the form of a Declaration under 37 CFR § 1.132, stating that the two specifically recited materials for the window in Davidson (fused quartz and BK-7 glass) are inoperable for thermal imaging of the present invention, which only utilizes wavelengths in the IR range, above 4 microns.

In the December 04, 2007 Final Office Action, the Examiner removed the rejection under 35 U.S.C. § 102(b).

Also in Applicant's reply to the June 26, 2006 non-final Office Action, Applicants pointed out that although the Paniccia reference uses a window material that is transparent to IR wavelengths, Paniccia does not show or suggest the window being part of a cooling system that uses coolant flowing through a duct so as to cool an electronic device, as recited in the independent claims of the instant application. In the Final Office Action of December 4, 2006, the Examiner maintained the rejection under 35 U.S.C. § 103(a) of Davidson in view of Paniccia.

In order to combine or modify references under 35 USC § 103, there must be a sufficient suggestion or motivation for combining the references with a reasonable expectation of success. MPEP § 2143. There is none in Davidson and there is none in Paniccia. To support the motivation to combine Davidson and Paniccia, the Examiner states on page 4 of the December 4, 2007 Final Office Action, "*By replacing the window with a window as taught by Paniccia, in order to provide a window having a desired thermal conductivity to remove heat depending on the heat removal requirements of a particular application, and since the particular type of material used to make the window is only considered to be the use of a "preferred" or "optimum" material out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have been able to provide based on intended use of applicant's apparatus, i.e., suitability for the intended use of applicant's apparatus, which in this case is to provide a window that is partially transparent to photons with wavelengths above 3.6 microns, as taught by Davidson and Paniccia.*" Regardless of how these two references are combined, Davidson and Paniccia will produce an inoperable result.¹ First of all, one would not be motivated to take the IR transparent

¹ Michael L McGinley versus Franklin Sports, Inc. (Fed Cir 2001) ("If references taken in combination would produce a 'seemingly inoperative device,' we have held that such references teach away from the combination and thus cannot serve as predicates for a *prima facie* case of obviousness."); In re Sponnoble, 405 F.2d 578, 587, 160 USPQ 237, 244 (CCPA 1969) (references teach away from combination if combination

window of Paniccia and place it in the liquid cooling duct of Davidson because the materials recited in Davidson for sensing polarization of light work well for their intended use, which is at lower wavelengths. Second, one would not be motivated to take the IR camera of Paniccia and use it to replace the polarization sensing device of Davidson, simply because Davidson would no longer be able to sense voltages through detection of light polarization. Therefore, Davidson would be inoperable. References that produce seemingly inoperative devices cannot serve as predicates for a *prima facie* case of obviousness.¹

On the other hand, if one were to take the glass of Paniccia and replace it with the glass of Davison, the IR detector of Paniccia would no longer function because IR wavelengths cannot pass through fused quartz or BK-7 glass.² In addition, Paniccia doesn't have, teach, or suggest a duct with coolant flowing through it, as recited in the independent claims of the instant application.

Therefore, one would not be motivated to combine the Paniccia reference with the Davidson reference or the Davidson reference with the Paniccia reference. When there is no suggestion or teaching in the prior art, the suggestion can not come from the Applicant's own specification. The Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP § 2143 and *Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and *In re Fitch*, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The prior art reference Davidson taken alone and/or in view of Paniccia does not suggest, teach or mention "a duct adapted to be coupled with an electronic device, wherein the electronic device forms one side of the duct; a coolant flowing through the duct so as to cool the electronic device; and a photon detector located adjacent to the duct for detecting photons emitted from the electronic device, wherein the duct and the coolant

produces seemingly inoperative device); see also *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (inoperable modification teaches away).

² See Applicant's June 26, 2006 Declaration under 37 CFR § 1.132.

are at least partially transparent to photons with wavelengths above 3.6 microns and the duct is made of at least one of polished silicon, quartz, sapphire, glass, and diamond," as recited in independent claim 7 of the instant application. The prior art reference Davidson taken alone and/or in view of Paniccia also does not suggest, teach or mention "detecting, by a photon-detector, photons from an electronic device during operation of the electronic device, the photons indicative of thermal characteristics of the electronic device, the photon detector located adjacent to a duct that is adjacent to the electronic device, wherein the electronic device forms one side of the duct and a coolant flows through the duct so as to cool the electronic device and the duct and the coolant are at least partially transparent to photons with wavelengths above 3.6 microns and the duct is made of at least one of polished silicon, quartz, sapphire, glass and diamond," as recited in independent claim 19 of the instant application.

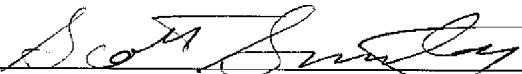
Accordingly, claims 7 and 19 distinguish over Davidson taken alone and/or in view of Paniccia. Dependent claims 3-6, 9-12, 15-18, 21-23, 29, and 30 are believed to be patentable as well because they are dependent on either claim 7 or claim 19. Applicants respectfully submit that the Examiner's rejection under 35 U.S.C. § 103(a) has been overcome.

Applicant's hereby respectfully request reconsideration and allowance of pending claims 3-12, 15-23, 29, and 30 of the instant application.

PLEASE CALL the undersigned if that would expedite the prosecution of this application.

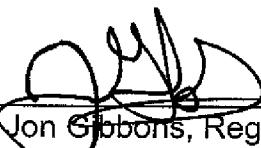
Respectfully submitted,

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